

REMARKS

Applicants acknowledge, with appreciation, the Examiner's withdrawal of the prior claim rejections and the allowance of claims 23, 27-34, 37, 38 and 40 of this application.

Applicants respectfully disagree with the Examiner's rejection of claims 35, 39 and 63-71 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. However, in order to advance prosecution of this application, applicants request cancellation of claims 35, 39, and 64-71, without prejudice, and reserve the right to file for and to obtain claims directed to this subject matter in a continuing or divisional application, claiming priority and benefit herefrom, or from a related application, under 35 U.S.C. § 120.

Claims 41, 44 and 47 are withdrawn from consideration. Applicants have cancelled claims 50 and 51 because the claims on which they depend (claim 35 and 36, respectively) have been cancelled. Applicants have amended withdrawn claims 41, 44 and 47 to reflect previous amendments to method steps of claims from which they depend. Applicants request that the Examiner reconsider the restriction of claims 41, 44 and 47 on the basis that a search of the subject matter of these claims would not be unduly burdensome. Claims 41, 44 and 47 are directed to a method of selecting a chemical entity whereby steps a to e are repeated with another chemical entity. Essentially two or more chemical entities are selected as in earlier claims searched and these entities are subsequently assembled after visual inspection. Because of the significant overlap with the searched claims, a search of subject matter of claims 41, 44 and 47 would not be unduly burdensome.

Applicants have amended claim 63 to delete reference to cancelled claim 35. Applicants have amended claim 38 to reflect previous amendments to method steps of claims from which it depends.

Applicants have added claims 72-85 to particularly point out and more clearly recite the intended scope. Support for these claims can be found throughout the specification as filed, for example, on page 16, line 3, to page 19, line 5; page 27, line 10, to page 30, line 16; page 32, line 32 to page 34, line 9; page 34, lines 10-17; and page 60, line 10, to page 61, line 2 (Example 6).

Claims 23, 27-34, 37-38, 40, 63, and 72-85 are pending in this application.

THE REJECTIONS

35 U.S.C. § 112, first paragraph

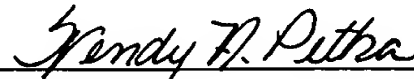
Claims 35, 39 and 63-71 stand rejected under 35 U.S.C. § 112, first paragraph, on the basis that the “claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.” Applicants disagree with the Examiner’s assertion. However, in order to advance prosecution, applicants have cancelled claims 35, 39 and 64-71, thus rendering moot the Examiner’s rejection of these claims.

Applicants have amended claim 63 to eliminate its dependency on cancelled claim 35. Applicants have not cancelled claim 63, because, as amended, it depends from allowed claims 23, 29 and 32. Support for claim 63 can be found throughout the specification, for example, at page 32, line 32 to page 33, line 17.

CONCLUSION

Applicants respectfully request that the Examiner consider the requested amendments and remarks, and pass this application to issue. If the Examiner believes that a telephone conference would be useful in expediting allowance of the claims, she is invited to contact the undersigned.

Respectfully submitted,



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